<u>R E M A R K S</u>

Claims 1, 10, 18, and 20 are amended. Claims 2-9, 11-17, and 19 stand as originally filed. Re-examination and reconsideration are requested.

5   In the office action, paper number (unspecified), dated October 10, 2006, the examiner objected to claim 18 as containing certain typographical errors, as set forth in section 5 of the office action. The examiner rejected claims 10 and 20 under 35 U.S.C. §112, second paragraph, as being indefinite for the
10   reasons specified in sections 6-9 of the office action. The examiner rejected claims 1-11 under 35 U.S.C. §101 as being directed to non-statutory subject matter. With regard to the art-based rejections, the examiner rejected claims 1-20 under 35 U.S.C. §103(a) as being obvious over the publication to Legato,
15   et al., entitled "Legato NetWorker Administrator's Guide ("Legato") in view of Cox, et al., U.S. Patent No. 5,535,335 ("Cox").

<u>Re the Claims</u>:

Claim 1 is amended to clarify that the status indicator is
20   provided for a user. Support for the amendments to claim 1 is found throughout the specification and claims as originally filed and more specifically at, for example, paragraph 18. No new matter is added.

Claim 10 is amended per the examiner's suggestion to correct
25   a minor typographical error. No new matter is added.

Claim 18 is amended per the examiner's suggestion to correct a minor typographical error. No new matter is added.

Claim 20 is amended per the examiner's suggestion to correct the typographical error regarding the dependency of claim 20.
30   No new matter is added.

<u>Re the Objections to Claim 18</u>:

The examiner objected to claim 18 as containing certain typographical errors. In response, applicants have amended claim

18 to correct the typographical error. Accordingly, the objections are overcome.

Re the Rejections of Claims 10 and 20:

The examiner rejected claims 10 and 20 as being indefinite under Section 112, second paragraph, for the reasons noted in sections 6-9 of the office action. Applicants have hereby amended claims 10 and 20 per the examiner's suggestions to correct the minor typographical errors which were the basis of the examiner's Section 112 rejections. Accordingly, applicants believe the Section 112 rejections to be overcome.

Re the Rejections of Claims 1-11:

The examiner rejected claims 1-11 under 35 U.S.C. §101 as being directed to non-statutory subject matter for the reasons specified in Section 8 of the office action. In response, applicants have amended claim 1 to clarify that the status indicator is provided to a user. The status indicator allows the user to more effectively manage the backup process and the backup media associated therewith. Consequently, the method defined by claim 1 is statutory in that claim 1 defines a method that has practical application within the technological arts, i.e., that of managing backup media. Stated simply, notifying a user (via the provision of a status indicator) of the status of a media job category is a practical and useful result of the type described in MPEP 2106 (2)(b)(ii) as comprising statutory subject matter. Consequently, claim 1, and the claims depending therefrom (i.e., claims 2-11) are believed to define statutory subject matter, and applicants respectfully request the examiner to remove the Section 101 rejections of claims 1-11.

Legal Standard For Rejecting Claims Under 35 U.S.C. §103

The test for obviousness under 35 U.S.C. § 103 is whether the claimed invention would have been obvious to those skilled

in the art in light of the knowledge made available by the reference or references. In re Donovan, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. In re Rinehart, 189 USPQ 143, 146 (CCPA 1976). All limitations of the claims must be considered. In re Boe, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of applicants' teachings. In re Meng, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a Section 103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. In re Lintner, 173 USPQ 560, 562 (CCPA 1972).

A basic mandate inherent in Section 103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Kamm, 172 USPQ 298, 301-302 (CCPA 1972). Put somewhat differently, the fact that the inventions of the references and of the applicants may be directed to concepts for solving the same problem does not serve as a basis for arbitrarily choosing elements from references to attempt to fashion applicants' claimed invention. In re Donovan, 184 USPQ 414, 420 (CCPA 1975).

A reference which teaches away from the applicants' invention may not properly be used in framing a 35 U.S.C. §103 rejection of applicants' claims. See United States v. Adams, 148 USPQ 429 (1966).

Re the Section 103 Rejections:

The examiner rejected claims 1-20 under 35 U.S.C. §103(a)

as being obvious over Legato in view of Cox. These rejections are improper in that the references fail to provide the suggestion or incentive required to combine them in the manner set forth by the examiner. Because of this lack of suggestion or incentive, neither reference can be used to establish the required *prima-facie* case of obviousness under Section 103. Therefore, the obviousness rejections of claims 1-20 are improper and must be removed.

The present invention is concerned with the management of media used to backup data and claims methods and systems for providing a status indicator for a media job category. Exemplary media job categories include one or more media movement categories, a device load category, a scratch media initialization category, and other categories of media jobs for managing media used to backup data. As illustrated in Figure 6, a user interface may be used to provide a status indicator for one or more of the media job categories (e.g., media movement, device load, and scratch initialization) based on the service level objective, thereby allowing a user to more effectively manage backup media.

The Legato reference is an administrator's guide for the Legato NetWorker (release 6.0, Unix version) software product. As described in the reference, the Legato NetWorker software provides a solution for network storage management to help protect and manage data across an entire network of computers. The NetWorker software is described as managing data, creating a database of saved data, and making it easy to locate data for recovery. See, for example, page 37 of the Legato reference. While the Legato reference describes that the NetWorker software "monitors data status," it does so only in the context of rotating "data through the tracking system as it reaches different levels of obsolescence." See page 38 of the Legato reference. However, and as confirmed by the examiner, the Legato reference fails to disclose several elements and limitations contained in the pending claims, including

"receiving a service level objective for a media job category and determining a status indicator for the media job category based on the service level objective and the status or each of the plurality of media jobs; and wherein said user interface is further configured to provide the status indicator for the media job category." Office action, page 5.

The Cox reference discloses a method and system for reporting the status of an aggregate resource in a network of interconnected real resources. Cox defines a real resource as

"an operative piece of hardware or software residing within a network, for example a communications network arranged in some hierarchical or other interconnected topological arrangement whose interconnection scheme and las reported physical status are maintained in a network topological and status database by a network management system, such as IBM Corporation's NetView product." Cox, col. 1, line 65 - col. 2, line 5.

Cox then goes on to define an aggregate resource as "a logical resource composed of or containing a number of real resources." Cox, col. 2, lines 9-11. According to Cox, the status of the aggregate resource is calculated based upon the status of the real resources that it contains rather than being determined by its own characteristic "since a determination based upon the real status of underlying elements will prove more reliable in estimating the ability of the aggregate resource to function." Cox, col. 2, lines 13-16.

Thus, Cox is concerned with "the problem of maintaining an accurate awareness of the status of logical or aggregate resources in a communications network," (col. 1, lines 21-24) so that an estimation can be made of the ability of an aggregate resource to function. Significantly, nowhere does Cox ever describe data backup operations, much less specific issues relating to the management of media used to backup data.

The examiner's obviousness rejections are erroneous in that nether Legato nor Cox provides the suggestion or incentive required to combine them in the manner urged by the examiner.

While the NetWorker software disclosed by the Legato reference aids in network storage management, it fails to disclose several elements and limitations contained in each of the rejected claims, as noted above. While the examiner cites to various portions of the Cox reference as containing disclosures that would fill in the gaps (i.e., the missing elements and limitations), the problem remains that the examiner has failed to identify any suggestion or incentive in either Legato or Cox that would motivate a person having ordinary skill in the art to make the combination.

First, a person having ordinary skill in the art would view Legato as satisfactorily addressing the network storage problem, because it is a solution and is presumed to function well. Legato even provides a solution that "monitors data status and automatically rotates data through the tracking system as it reaches different levels of obsolescence." Legato mentions no need for additional status monitoring. Consequently, Legato cannot be said to provide the suggestion or incentive to provide any additional functionality in this regard. Of course, Cox makes no reference of data backup at all, much less identifies any problems or issues relating to the management of the backup process. The only place were there is identified a need to provide additional status functionality is in the teachings of the present invention. However, the teachings of the present invention cannot be used as a guide to piece together the prior art.

In addition, even if it were proper to combine Legato and Cox (which is denied), the resulting combination would still fail to meet the limitations of the pending claims. For example, while the examiner asserts that the "service level objective" of the pending claims is met by Cox's "stored parameter values," there is no indication in Cox that his "stored parameter values" is synonymous with "service level objective," nor has the examiner provided any evidence that the two terms means the same thing. The examiner also asserts that Cox's "aggregate resource"

is the same as a media job category. However, and as discussed above, Cox's "aggregate resource" is defined as a logical resource composed of or containing a number of real resources. Clearly, Cox's "aggregate resource" cannot reasonably be said to be the same as "a media job category" of the pending claims. Therefore, even if Legato and Cox are combined, the resulting combination still would not meet the limitations of the pending claims.

In summation, then, claim 1 is allowable because neither Legato nor Cox provide the suggestion or incentive required to combine them in the manner required by pending claim 1. In addition, even if it were proper to combine Legato and Cox, which is denied, the resulting combination still would fail to make obvious pending claim 1, at least because Cox's "stored parameter values" are not the same as the "service level objective" and because Cox's "aggregate resource" is not a "media job category." Consequently, claim 1 is not *prima-facie* obvious over Legato and Cox.

Dependent claims 2-11 are allowable over Legato and Cox at least because they depend from claim 1, which is allowable over Legato and Cox.

Independent claim 12 is allowable over Legato and Cox because neither reference provides the suggestion or incentive required to combine them in the manner required by claim 12. Moreover, even if it were proper to combine Legato and Cox, the resulting combination still would not meet the limitations of pending claim 12, because Cox's "stored parameter values" are not the same as the "service level objective" and because Cox's "aggregate resource" is not a "media job category." Consequently, claim 12 is not *prima-facie* obvious over Legato and Cox.

Dependent claims 13-16 are allowable over Legato and Cox at least because they depend from claim 12, which is allowable over Legato and Cox.

Independent claim 17 is not obvious over Legato and Cox

because neither reference provides the suggestion or incentive required to combine them in the manner required by claim 17. Even if Legato and Cox were combined, the resulting combination still would not meet the limitations of pending claim 17, because Cox's "stored parameter values" are not the same as the "service level objective" and because Cox's "aggregate resource" is not a "media job category." Therefore, claim 17 is not *prima-facie* obvious over Cox and Legato.
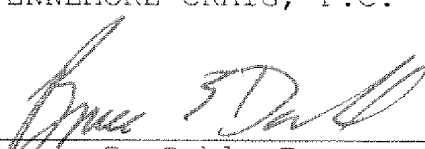
Dependent claims 18-20 are not obvious in light of Legato and Cox at least because they depend from claim 17, which is not obvious in light of Legato and Cox.

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Applicants believe that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicants respectfully request the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the applicants' attorney at the telephone number listed below.

Respectfully submitted,

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